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PATENT, TRADEMARK, COPYRIGHT
 AND UNFAIR COMPETITION LAW
 AND RELATED LITIGATION

January 10, 2001

FACSIMILE COVER SHEET

EDMUND P. WOOD
 1923-1968
 TRUMAN A. HERRON
 1935-1978
 EDWARD B. EVANS
 1936-1971

TRADEMARK AND INT'L
 PATENT ADMINISTRATION
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To: Examiner Cheryl Juska
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From: Keith R. Haupt

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Re: Serial No. 09/558,329
 Our File: STAN-09RE

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MESSAGE/COMMENTS

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1/10/01
Date

PATENT

Serial No.: 09/558,329
Filed: April 25, 2000
Applicant: Randolph A. Stern and Michael N. Byles
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith
Examiner: Cheryl Juska
Group Art Unit: 1771
Attorney Docket: STAN-09RE

Cincinnati, OH 45202

January 10, 2001

Assistant Commissioner of Patents
Washington, D.C. 20231

RESPONSE TO OFFICIAL ACTION

This is in response to the Official Action dated September 22, 2000 in which claims 1-87, all of the claims pending in this reissue application, were rejected. An Extension of Time is submitted herewith. On December 21, 2000, the undersigned attorney had an opportunity to interview the Examiner handling this reissue application regarding the Official Action. Applicants greatly appreciate the cooperation and courtesy extended by the Examiner during the interview.

Section 112 Rejection

Claims 30-87 were rejected under 35 U.S.C. §112, first paragraph, as being allegedly based upon a disclosure which is not enabling. Claims 30-87 are

all of the claims which Applicants seek to add to the patent (U.S. Patent No. 5,902,757) in this reissue application.

Claims 30-57 each recite a felt web having an upper surface and a lower surface and claims 58-87 each recite a first layer of felt having an outer surface. Applicants submit that there can be no dispute that the claims as pending read on the disclosure in the '757 patent specification. However, the Official Action alleges that the properties of the felt must also be claimed in order to be enabling. The Official Action cites In Re Mayhew, 527 F.2d 1229, 188 U.S.P.Q. 356 (CCPA 1976) in support of the rejection. As discussed with the Examiner during the interview, and detailed hereinbelow, the claims are enabled by the disclosure and Mayhew does not support the rejection.

In Mayhew, the claims were directed to a process for producing zinc alloy. There was no dispute that if the process did not include a cooling step, the claimed invention was inoperative. The Court had no problem, therefore, affirming the rejection of claims lacking any mention of the cooling step as not being enabled. That was not the end of the Mayhew case, however.

In addition to rejection of claims lacking the cooling step in its entirety, the Examiner had also rejected claims which recited the cooling step, but omitted the temperature or function of the cooling step. The Court reversed the rejection of those claims holding that the claims are sufficiently enabled without requiring recitation of the properties set forth the preferred embodiments. Thus, Mayhew stands for no more than that the critical elements of a functional invention must be

present in the claims to be enabling, whereas lack of specific properties of those elements is not fatal to the claims. That is precisely the situation here. The pending claims do recite the critical elements, i.e., yarns and felt, which are necessary ingredients for a stitch bonded fabric of the invention. Mayhew does not stand for the proposition that the properties of the felt (e.g, hydrophobic and/or hydrophilic) must be recited in the claims, for a product made with a felt lacking those properties would still be a functional stitch-bonded fabric.

The properties of the felt being hydrophobic and/or hydrophilic are not critical or essential to the invention. Rather, what is essential is that yarns are stitch bonded to felt in such a manner as to create yarn faces such that the felt is not readily visible through the yarn face. More will be said about this feature when the prior art rejections are addressed below. For purposes of the Section 112, paragraph 1, rejection, Applicants submit that the focus in the Official Action is too narrow and properties which are not essential to a functional fabric or pad made with such fabric are not required in §112, ¶1. For example, in the Mayhew case, the claim held by the Court to be nonenabling was inoperative because a critical feature or element of that invention was not recited in the claim is in contrast with the undeniable fact that one of ordinary skill in the art of incontinent pads and similar products would readily utilize any number of felt web materials which are well known to practice the invention of claims 30-87, including but not limited to layers of hydrophobic/hydrophilic materials as disclosed in the '757 specification.

The invention of claims 30-87 is directed to a stitch-bonded facing fabric, an incontinent pad and/or a fluid retaining product. Such products are typically employed in hospital situations to retain fluids expelled from the body while also protecting bed linens, clothing and the like. Typical prior art incontinent pads have a knitted or woven facing fabric layer, typically of cotton (e.g., Birdseye) to which is quilted a felt layer. In fact, a vast majority of all prior art products of this type include a facing fabric of cotton (and not combined hydrophobic/hydrophilic properties), and a felt web or felt layer of material having one of these properties. It is thus not correct, as the Official Action alleges, that all prior art pads have combined hydrophobic and hydrophilic components in the facing fabric. Rather, that special type of fabric is the property of Applicants' assignee and is used in one style of their pad.

The vast majority of incontinent pads in the marketplace, however, are typically of Birdseye cotton facing fabric and felt which are quilted together. The Official Action incorrectly infers that, simply because one style of pad was specifically referenced in the '757 patent, that the wider body of such products could be ignored. Indeed, the specification of the present case merely referred to the Comply[®] fabric as but "one" fabric, and not as a representative of the entire spectrum of facing fabrics which could be utilized in the invention.

Thus, while the product which is described in specific embodiments in the '757 patent is an incontinent pad, stitch bonded fabric or fluid-retaining fabric in which the felt web or felt layer is comprised of a specific combination of

hydrophobic and hydrophilic layers, Applicants submit that the invention is not so limited. In that regard, claims 30-87 are broader than the hydrophilic/hydrophobic felt materials recited in claims 1-29. Nevertheless, Applicants respectfully assert that the '757 patent specification is fully enabling with respect to claims 30-87 because one of ordinary skill in the art would readily be able to identify a vast array of felt webs or felt layers without undue experimentation that could be utilized in the invention of claims 30-87.

To be enabling under §112, a patent specification must disclose sufficient information to enable those skilled in the art to make and use the claimed invention. Spectra-Physics, Inc. v. Coherent, Inc., 3 U.S.P.Q. 2d, 1737, 1743 (Fed. Cir. 1987), citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986), cert. denied, 107 S. Ct. 1606 (1987).

The proper test of enablement is whether one reasonably skilled in the art could make or use the invention from the specification's disclosure with information known in the art and without undue experimentation. U.S. v. Teletronics, Inc., 8 U.S.P.Q. 2d 1217, 1223 (Fed. Cir. 1988) citing Hybritech, Inc., 231 U.S.P.Q. at 94. Applicants respectfully assert that since at least one embodiment of a felt web or felt layer is disclosed in the '757 patent specification that other permutations of the invention as recited in claims 30-87 could be practiced by those skilled in the art without undue experimentation. See SRI International v. Matsushita Electric Corp., 227 U.S.P.Q. 577, 586 (Fed. Cir. 1985)

(the law does not require an applicant to describe in his specification every conceivable embodiment of the invention).

Furthermore, the present invention is directed to stitch bonded fabric and fluid retaining fabric which are used in incontinent pads. This art is not a chemical related art in which the results of experiments are not predictable. The invention is more related to mechanical arts in which the results of experiments are highly predictable. As such, where the results are predictable, broad claims, such as claims 30-87, can be enabled by the disclosure of a single embodiment of the invention. Spectra-Physics, 3 U.S.P.Q. 2d at 1743.

Further, a claim is not invalid for lack of enablement simply because it reads not only on the disclosed embodiment of the invention, but also on other embodiments which may or may not be adequately disclosed in the specification. See Gould v. Mossinghoff, 219 U.S.P.Q. 393, 396 (D.C. Cir. 1983) aff'd, 3 U.S.P.Q. 2d 1302 (Fed. Cir. 1987).

Thus, Applicants respectfully assert that claims 30-87 are compliant with Section 112, first paragraph, in that they claim a felt web or layer of felt material irrespective of whether such an embodiment was specifically disclosed in the '757 patent specification. The enablement requirement does not require that the patent disclose every embodiment of the claim and that a broad claim can be enabled by the disclosure of a single embodiment. See Cross v. Iizuka, 224 U.S.P.Q. 739, 748 (Fed. Cir.); Gould v. Mossinghoff, 229 U.S.P.Q. 21, 14 (D.D.C. 1985).

The PTO Board of Patent Appeals and Interferences has also acknowledged that claims which are broader than the specific embodiments of the invention disclosed in the specification are enabling and that in mechanical cases and other predictable arts, broad claims may cover more than the specific embodiment disclosed in the specification. Ex Parte Alan J. Knobbe et al., Appeal No. 92-1191, page 4 (PTO Brd. Pat. App. & Int., 1992) citing In Re Vickers, 61 U.S.P.Q. 122 (CCPA 1944) and In Re Newton, 163 U.S.P.Q. 34 (CCPA 1969).

For all these reasons, Applicants respectfully assert that the Section 112, first paragraph, rejection of claims 30-87 is improper and request that it be withdrawn.

Prior Art Rejections

All of the claims in this reissue application have been rejected based upon one or more of U.S. Patent No. 4,026,129 issued to Sternlieb, U.S. Patent No. 4,181,514 issued to Lefkowitz, U.S. Patent No. 4,675,226 issued to Ott, U.S. Patent No. 5,356,402 issued to Gillies, U.S. Patent No. 4,128,686 issued to Kyle and European Patent No. 261,904 issued to Taylor. As discussed during the interview with the Examiner, Applicants respectfully traverse each of these prior art rejections and asserts that pending claims 1-87 are patentably novel and non-obvious.

Each of the claims specifically recite a plurality of stitch bonding yarns which extend through the felt web. The stitch bonding yarns are identified by

reference number 18 in the '757 patent and include yarn segments 18' and 18" which extend over or across the upper surface 20 of the web and the lower surface 22 of the web, respectively. This arrangement is particularly shown in Figs. 2 and 5 of the '757 patent. The yarn segments contribute to form a top yarn face 24 and a bottom yarn face 26 of the finished fabric which is described in the '757 patent as follows:

It will be appreciated that yarn segments 18' and 18" do not become embedded into the web 12 below surfaces 20 or 22 thereof, but rather extend across the surfaces 20 and 22, and are of sufficient density that yarn segments 18' cooperate to define a top yarn face 24 of fabric 10 above web upper surface 20, and yarn segments 18" cooperate to define a bottom yarn face 26 of fabric 10 below web lower surface 22. Faces 24 and 26 are effectively continuous such that web 12 is not exposed thereat, although small gaps or interstices (as at 28) between adjacent yarn segments 18' or 18" may allow viewing of felt surface 20 or 22 upon close inspection. It will be noted that Figs. 3 and 4 are greatly exaggerated to show interstices 28 in faces 24 and 26. (Col. 2, lines 52-65).

Applicants respectfully assert that the yarn faces recited in each of the pending claims is a feature of the fabric or other product according to this invention that is not shown, disclosed, or otherwise suggested in the cited art. In other words, the resulting product according to this invention includes an upper and/or a lower face which is comprised of yarn segments of the stitch bonding yarns and the yarn faces are effectively continuous such that the felt web is not exposed. The benefit of the yarn faces is that the fabric for the incontinent pad then has a comfortable surface for the patient at the top yarn face and/or the bottom yarn face provides a surface for adhesive connection to a barrier layer without interfering with

either the structural rigidity or absorbency provided by the felt web. Applicants respectfully assert that the yarn face recited in each of the pending claims is a feature that is not present, disclosed or suggested in the prior art.

During the interview, the undersigned attorney understood that the Examiner appreciated this distinction over the prior art and, pending the outcome of a review of the art and reconsideration of the rejection, this feature of the invention would be deemed allowable over the art of record.

By comparison, the Sternlieb '129 patent clearly discloses and teaches in Fig. 7 portions or ribs of the felt web 31 that are exposed and project beyond the upper surface of the stitch bonding yarn segments 11 and 13. The Lefkowitz patent shows a fibrous bat 2 with a number of stitch yarns 3, 4 significantly spaced from one another as shown particularly in Figs. 3 and 7 of that reference.¹

The Ott patent discloses that the preferred stitch used in that product is a length of 3 mm and is spaced in the cross web direction at 14 stitched lines per inch or 14 gauge. (Col. 3, lines 31-34). The Gillies patent discloses a polyester thread having a thickness of approximately 150 denier in which the stitch bonding rows are spaced apart to give approximately 2 to 10 rows per inch and most preferably 5 rows per inch such that each row contains approximately 6 to 20 stitches and most preferably 12 stitches per inch. (Col. 5, lines 25-36). The result

¹ The identified figures in Sternlieb '129 and Lefkowitz are considered to accurately portray those respective inventions in contrast to Figs. 3 and 4 in the '757 patent which are greatly exaggerated as previously discussed.

of such a low density in both Ott and Gillies is necessarily to create large open gaps rather than an effectively continuous face.

These and the other prior art documents cited in the rejections of claims 1-87 fail to disclose, teach or otherwise suggest a yarn face at the top and/or bottom surfaces as in Applicants' claimed invention. Applicants respectfully assert that the teaching of these prior art patents would lead one of ordinary skill in the art directly away from Applicants' claimed invention in which the stitch bonding yarn segments contribute to define top and bottom yarn faces that are effectively continuous such that the web is not exposed. Moreover, Applicants respectfully assert that one of ordinary skill in the art would readily be able to optimize the stitch density relative to the selected stitch thickness or denier for a particular application to achieve the yarn faces as described in Applicants' claims.

For all these reasons, Applicants respectfully assert that claims 1-87 are neither anticipated by nor rendered obvious in view of the cited references.

Summary

As a result of the comments provided herein, Applicants respectfully assert that the Section 112 and the prior art rejections are improper and should be withdrawn for the reasons detailed hereinabove and discussed during the personal interview with the Examiner.

Applicants note that the original patent or an Affidavit or Declaration as to the loss or inaccessability of the original patent must be provided to the